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March 7, 2014

BY ELECTRONIC FILING

Honorable Renee M. Bumb, U.S.D.J.
United States District Court for the District of New Jersey
Mitchell H. Cohen Federal Courthouse
1 John F. Gerry Plaza - Room 2010
Camden, NJ 08108

**Re: AstraZeneca LP and AstraZeneca AB v. Breath Limited et al.
Consolidated Civil Action No. 08-cv-01512 (RMB-AMD)**

Dear Judge Bumb:

We, along with our co-counsel, Steptoe & Johnson LLP, represent Sandoz Inc. (“Sandoz”) in the above-consolidated matter. We write on behalf of Sandoz to respectfully request that the Court reinstate Sandoz’s counterclaims of non-infringement and invalidity as to U.S. Patent No. 7,524,834 B2 (“the ‘834 patent”), and for a declaration of exceptionality under 35 U.S.C. § 285, warranting reimbursement of attorneys’ fees, costs, and expenses.

On May 31, 2013, the Court issued an Order of Final Judgment. (ECF No. 823). In that amended Judgment, the Court held that, as relevant here, Sandoz does not infringe claims 50 and 51 of the ‘834 patent, the only claims AstraZeneca asserted during trial that Sandoz infringed. (*Id.* at 3). In that same Order of Final Judgment, the Court dismissed *without prejudice* Defendants’ counterclaims of invalidity as relevant to the ‘834 patent. (*Id.*). As this Court is aware, on October 30, 2013, the Federal Circuit reversed this Court’s non-infringement finding as to the ‘834 patent and remanded for further proceedings. AstraZeneca subsequently filed a motion for a preliminary injunction before this Court, which is fully briefed.

In view of the procedural nature of this case, Sandoz seeks to reinstate its counterclaims relevant to the ‘834 patent. (See ECF No. 12, DEFENDANT SANDOZ INC.’S ANSWER,

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AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS in Civil Action No. 1:10-cv-5785¹). We respectfully submit that it is appropriate for this Court to proceed in this manner. *See, e.g., Free Motion Fitness, Inc. v. Cybex Int'l, Inc.*, 423 F.3d 1343, 1353 (Fed. Cir. 2005) (stating that parties “are free, of course, to reinstate their counterclaims upon remand”).

On March 5, 2014, Defendants Breath Limited and Watson Laboratories, Inc. (collectively “Watson”) submitted a request that the Court reinstate Watson’s counterclaims of invalidity as to the ’834 Patent, (ECF No. 926), which this Court granted on March 6, 2014 (ECF No. 927).

We thank the Court for its consideration and continued assistance in this matter. Naturally, if the Court has any questions or would prefer to schedule a conference to discuss these matters, we would be pleased to be available at the Court’s convenience.

If Sandoz’s request herein meets with the Court’s approval, we respectfully request that Your Honor execute the “So Ordered” provision below and have this letter filed with the Clerk of the Court.

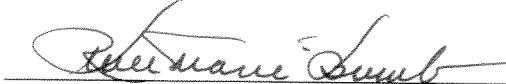
Respectfully,

/s/ Sheila Raftery Wiggins
Sheila Raftery Wiggins

SRW:sm

cc: All parties of record via ECF

IT IS SO ORDERED this 10th day of March, 2014, that the above request for the reinstatement of Sandoz Inc.’s counterclaims of non-infringement and invalidity as to the ’834 Patent, and for a declaration of exceptionality under 35 U.S.C. § 285 in this matter is hereby granted; and it is further ORDERED that Sandoz Inc.’s counterclaims of non-infringement and invalidity as to the ’834 Patent and for a declaration of exceptionality under 35 U.S.C. § 285 are hereby reinstated.


THE HONORABLE RENEE MARIE BUMB
UNITED STATES DISTRICT JUDGE

¹ The Court consolidated Civil Action No. 1:10-cv-5785-RMB-AMD with lead Civil Action No. 1:08-cv-1512 on March 16, 2011. (See ECF No. 44 in Civil Action No. 1:10-cv-5785; ECF No. 268 in Civil Action No. 1:08-cv-1512).